



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,746	10/15/2001	David Llewellyn Mallis	09432.183002	3552
22511	7590	12/27/2005	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			BOCHNA, DAVID	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claim 10, lines 9-10 state that “irreversible plastic deformation of the positive stop torque shoulder does not occur upon final makeup”.

This appears to be inconsistent with the specification as originally filed which on page 6, lines 1-2 states that torque “may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation”. Thus the claims purport that no irreversible plastic deformation occurs at final makeup yet the specification only supports no irreversible plastic deformation prior to final make up. See also page 7, paragraph (0031).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3679

4. Claims 10-11, 15-18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Klementich '315. The Klementich '315 rejection which was made in the final office dated 12/22/04 is being maintained and incorporated here by reference to that final office.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klementich in view of Blose '081. The Klementich '315 in view of Blose '081 rejection which was made in the final office dated 12/22/04 is being maintained and incorporated here by reference to that final office.

***Response to Arguments***

7. Applicant's arguments filed 3/22/05 have been fully considered but they are not persuasive.

Applicant argues that the 112, 1<sup>st</sup> paragraph rejection should be removed because the specification as originally filed recited that torque "may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation". Applicant argues that if no irreversible plastic deformation occurs prior to final makeup, one of ordinary skill in the art would conclude that no plastic deformation would occur upon final makeup.

The Examiner disagrees with this assertion. There is no reason for one of ordinary skill in the art to assume that when torque may be applied to the positive stop torque shoulder prior to

Art Unit: 3679

final make up, without causing irreversible plastic deformation, that no plastic deformation would not occur upon final makeup.

Applicant argues that “upon final makeup” is effectively equivalent to not having plastic deformation “prior to final make-up”. The Examiner disagrees, as the words “upon” and prior to” are not synonymous. Applicant uses the example of 5000 ft\*lbs being “upon” and 4999 ft\*lbs being “prior to”, and that it wouldn’t be possible to have plastic deformation at 5000 ft\*lbs if there was no plastic deformation at 4999 ft\*lbs. It is unclear to the Examiner why plastic deformation couldn’t occur at 5000 ft\*lbs when there was no plastic deformation at 4999 ft\*lbs. There has to be a threshold pressure value when plastic deformation of the metal begins to occur, and there is no reason it could not be when the last ft\*lb of pressure is added “upon” final make up of the joint.

Applicant also argues that Klementich does not disclose the limitation that “a torque is applied such that irreversible plastic deformation of a torque shoulder does not occur upon final makeup”, and cites various lines from Klementich to support this argument. However, none of the references to Klementich disclose that the shoulders of Klementich are plastically deformed. The references cited by the Applicant only state that the shoulders of Klementich touch to form a seal. The shoulders 520, could only be elastically deformed, or not deformed at all, and still create the desired seal. Applicant argues that it is apparent that plastic deformation is relied upon in Klementich in order to form the metal-to-metal seals, but has failed to point out any evidence in the specification of Klementich that supports this argument.

Art Unit: 3679

Applicant argues that Blose teaches plastic deformation and therefore teaches away from Klementich. However, Blose is used to teach the use of positive stop shoulders, not plastic or elastic deformation, therefore the obvious type rejection has been maintained.

***Conclusion***

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**9.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 3679

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David Bochna", with a long horizontal flourish extending to the right.

David E. Bochna  
Primary Examiner  
Art Unit 3679